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AF/3711\$

App. Serial No.: 09/748,046

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application of:

Yoshihiko Shioda )

Serial No.: 09/748,046 )

Filed: December 22, 2000 )

For: GOLF PRACTICE SYSTEM )

DOCKET: 019441.034

Examiner: Mark S. Graham

Art Unit: 3711

Charlotte, North Carolina April 1, 2003

Commissioner for Patents  
Washington, D.C. 20231RECEIVED  
APR 07 2003  
TECHNOLOGY CENTER R3700APPEAL BRIEF

Sir:

I. Real Party in Interest

The real party in interest with regard to the present application is Yoshihiko Shioda.

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## **II. Related Appeals and Interferences**

Appellant is not aware of any related appeals or interference proceedings.

## **III. Status of Claims**

Claims 1, 5, 6, 11, 12, 18 and 19 are presently pending in the present application. Claims 2 and 3 have been cancelled. Claims 4, 7-10, 13-17 and 20-44 have been withdrawn in response to a requirement for restriction. As Claims 7-10, 13-17 and 20-31 all depend from Claim 1, they should be allowable upon a determination of the allowability of Claim 1. Appealed Claims 1, 5, 6, 11, 12, 18 and 19 are reproduced in Appendix A attached hereto.

Claims 1, 5, 6, 11, 12, 18 and 19 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The rejection states that because soccer balls come in all sizes and can be “non-inflated” to various degrees, it is unclear what limits are placed on the ball by the “non-inflated soccer ball” recitation.

Claims 1, 5, 18 and 19 stand rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103 (a) as obvious over Armstrong, III et al. U.S. Patent No. 6,217,458 (Armstrong). The rejection states that, because it is unclear what size ball is contemplated by the claims, Armstrong’s tennis ball sized ball anticipates the claimed device. Alternatively, Armstrong states that the ball may be made of whatever size is desired. The rejection concludes by stating that it would have been obvious to have made the ball of the size recited by the Applicant.

Claims 6, 11 and 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Armstrong in view of Hawkins, Sr. et al. (Hawkins) U.S. Patent No. 4,989,876 or Bottiglieri U.S.

Patent No. 5,407,211 (Bottiglieri). The rejection states that Armstrong discloses the claimed system with the exception of the type of target used and that such targets are commonly known and used in the art as typified by Hawkins and Bottiglieri. The rejection concludes that it would have been obvious to one of ordinary skill in the art to use such a target in Armstrong's systems as well in order to add interest to the game.

There are no other claims pending, cancelled or withdrawn that are associated with this application.

#### **IV. Status of Amendments**

All amendments have been entered.

#### **V. Summary of the Invention**

The golf practice and exercise system of the invention of the claims on appeal includes a practice ball and a target assembly, and may be combined with a golf club. The practice ball is a flexible, hollow uninflated practice ball of at least the approximate size of a non-inflated soccer ball to provide a large target so that the golfer can swing freely without concentrating on striking a small target, such as a regulation golf ball. The practice ball also has a weight exceeding that of a regulation golf ball to provide substantial resistance to the impact of a golf club to impose muscular strain on the golfer for muscle development, but the practice ball is limited in weight to allow the golfer to complete the follow-through of the golf swing. Thus, the system of the present invention provides for practicing the technique of the golf swing, as well as providing muscle development to enhance the striking force exerted by the golfer when striking a golf ball.

The practice ball is generally spherical and made of a pliable material. In the preferred embodiment, the practice ball may be substantially the same as a non-inflated soccer ball or a volleyball. The practice ball has an internal pressure of about atmospheric pressure to provide resistance for exercising muscles, prevent injuries to the user and to provide it with a low coefficient of elastic restitution to limit the distance traveled by the practice ball upon impact with a golf club and to limit the rebound of the practice ball upon contact with the target assembly. The practice ball is not tethered nor in any way configured to be attached to a tether.

The practice ball is such that if the user strikes the practice ball from a striking position a sufficient distance from the target assembly, approximately 10 to 40 feet, the practice ball will travel in the manner corresponding to the golf swing – an incorrect swing may cause the ball to curve either right or left and a correct swing will cause the ball to travel in a direct path. The greater the distance between the striking position and the target assembly, the more obvious the travel path of the practice ball.

The target assembly has an energy absorbing surface, preferably mesh netting attached to a rigid net frame. The rigid net frame is supported by a frame support structure that maintains the rigid net frame in the proper spatial orientation. In one form, the frame support structure is made up of a base upon which rests the rigid net frame, the base being of sufficient size to prevent the rigid net frame from becoming unbalanced upon contact by the practice ball. The frame support structure is preferably made up of a plurality of essentially triangular members, one member attached to or integral to each vertical side of the rigid net frame. (Specification, page 2, line 22 through page 4, line 18)

The present invention provides a combination for practicing control of the direction of flight of the ball as well as building the muscles used in swinging a golf club. The present

invention allows the golfer to watch the travel path of the practice ball, thereby confirming the consequence of each practice swing. But, the target assembly limits the distance the practice ball travels so a golfer can use the present invention in a confined space if desired. Also, the practice ball is of the size and mass that provides significant resistance to the golf swing, thereby providing the golfer with muscle building exercise to increase the golf swing power.

(Specification, lines 13-20)

## **VI. Issues**

There are four issues on appeal: first whether Claims 1, 5, 6, 11, 12, 18 and 19 are indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention as required by 35 U.S.C. 112, second paragraph; second, whether Claims 1, 5, 18 and 19 are unpatentable under 35 U.S.C. 102(e) as anticipated by Armstrong; third whether Claims 1, 5, 18 and 19 are unpatentable as obvious over Armstrong pursuant to 35 U.S.C. 103(a); and, fourth, whether Claims 6, 11 and 12 are unpatentable over Armstrong in view of Hawkins or Bottiglieri pursuant to 35 U.S.C. 103(a).

## **VII. Grouping of Claims**

With respect to the issues on appeal, Claims 1, 5, 6, 11, 12, 18 and 19 stand or fall together.

## **VIII. Argument**

THE REJECTION OF CLAIMS 1, 5, 6, 11, 12, 18 AND 19 AS BEING INDEFINITE PURSUANT TO 35 U.S.C. 112, SECOND PARAGRAPH, SHOULD BE REVERSED

BECAUSE THE TERM “AT LEAST THE APPROXIMATE SIZE OF A NON-INFLATED SOCCER BALL” IS NOT INDEFINITE.

In the final Office Action of November 4, 2002, the Examiner rejected Claims 1, 5, 6, 11, 12, 18 and 19 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and claim the subject matter which applicant regards as the invention “[B]ecause soccer balls come in all sizes and can be ‘non-inflated’ to various degrees.” The rejection stated that it was unclear what limits are placed on the ball by the “non-inflated soccer ball” recitation.

With regard to the size limitation recited in Claim 1, i.e., at least the approximate size of a soccer ball, the Examiner states that he has seen “soccer balls” as small as a tennis ball for small children or for dogs so that they may get the ball in their mouth. This makes no sense and renders the term “soccer ball” meaningless, which it of course is not. Patents are intended for practical application, not imaginary interpretation. This is well established by the rule that claims terms are to be given their common, ordinary meaning, unless a special definition is provided in the patent. In the context of Claim 1 and the disclosure in the specification, a soccer ball is a soccer ball not a tennis ball or a ball to be put in a dog’s mouth. The fact that a tennis ball could be used to play a pseudo-soccer game does not make a tennis ball a soccer ball under the common and ordinary meaning of a soccer ball. No one familiar with soccer or tennis would refer to a tennis ball as a soccer ball. If one were to ask a tennis player or a soccer player to identify a soccer ball, the player certainly would not point to a tennis ball. A soccer ball is generally of the size resembling that of the size specified by the official Laws of the Game of the international Football Association Board having a circumference of not more than 28 inches and not less than 27 inches. (See Appendix B)

Clearly the term “at least the size of a soccer ball” in Claim 1 is not indefinite, but rather provides a clear understanding of the claimed ball size.

In the final Office Action of November 4, 2002, the Examiner asserts that the claim term “non-inflated” is indefinite because a soccer ball can be “non-inflated” to various degrees. Here again, there is no basis for giving the term any meaning other than its common ordinary meaning. Non-inflated means it is not inflated. There is no such thing as partially non-inflated. It is either non-inflated or partially inflated. There is no degree of non-inflated.

In the second paragraph of page 3 of the Office Action of November 4, 2002, the Examiner states:

Moreover, Applicant is claiming another variable - the degree of inflation which adds a further degree of uncertainty to the limitations of the size of the ball.

Here, the Examiner is confusing “degree of inflation” with “non-inflated.” Certainly there are degrees of inflation. If something is inflated at all, it is not non-inflated. There is no common ordinary expression for a degree of “non-inflated.”

Clearly, there is no justification for contending that the term “non-inflated” appearing in Claim 1 is indefinite.

THE REJECTION OF CLAIMS 1, 5, 18, AND 19 AS ANTICIPATED BY ARMSTRONG PURSUANT TO 35 U.S.C. 102(e) SHOULD BE REVERSED BECAUSE ARMSTRONG DOES NOT DISCLOSE EACH AND EVERY ELEMENT RECITED IN THE CLAIMS.

The rejection of Claims 1, 5, 18 and 19 pursuant to 35 U.S.C. 102(e) asserts two alternative bases. First, the Examiner states that it is unclear what size ball is contemplated by the claims and that Armstrong’s tennis sized ball anticipates the ball of the claim. However, as discussed above, the size of the ball expressed in Claim 1 is definite and certainly is not the size

of tennis ball as disclosed in Armstrong. Therefore, this basis of rejection has no merit and should be reversed.

Alternatively, the Examiner rejects Claims 1, 5, 18 and 19 pursuant to 35 U.S.C. 102(e) on the basis of Armstrong, stating that a ball may be made of whatever size is desired. This rejection is without merit as Armstrong specifically discloses a tennis ball in the only disclosure of the size of the ball. This is stated in column 2, lines 55-59 of Armstrong, which reads:

Looking at Fig. 5(a) the ball 30 of the game apparatus 10 is typically slightly smaller than a conventional tennis ball (approximately 2.5 inches in diameter), although the size can be varied according to the choice of the player.

The disclosure of a ball slightly smaller than a conventional tennis ball of approximately 2.5 inches in diameter along with the broadening statement that the size can be varied according to the choice of the player is certainly not a disclosure or suggestion that the ball can be approximately the size of a soccer ball or larger. There is nothing in Armstrong that would teach or suggest the use of a ball at least as large as a soccer ball, particularly as the specific disclosure is of the use of a ball slightly smaller than a tennis ball. Patents are to be interpreted as they would be by one of ordinary skill in the art with terms being given their common ordinary meaning. From a practical standpoint there is no basis whatsoever for one to expand the disclosure in Armstrong from the disclosure of a tennis ball to encompass a soccer ball.

Significantly, the Examiner does not contend that there is any disclosure of a non-inflated ball in Armstrong. Rather, the Examiner only states that the term “non-inflated” is indefinite. As explained above, “non-inflated” is definite. Therefore, as there is no disclosure of “non-inflated” in Armstrong there can not be any anticipation.



Therefore, the rejection of Claims 1, 5, 18 and 19 as being anticipated by the Armstrong patent should be reversed.

THE REJECTION OF CLAIMS 1, 5, 18 AND 19 AS BEING OBVIOUS OVER ARMSTRONG PURSUANT TO 35U.S.C. 103(a) SHOULD BE REVERSED BECAUSE THERE IS NO SUGGESTION IN ARMSTRONG THAT RENDERS OBVIOUS EACH AND EVERY ELEMENT OF THE CLAIMS.

For the reasons stated above, there is no disclosure in Armstrong of a soccer ball, nor is there any suggestion in Armstrong of the “non-inflated” element of the claims, and, notably, the Examiner makes no assertion that “non-inflated” is obvious from Armstrong.

Therefore, there is no basis for an obviousness rejection of Claims 1, 5, 18, and 19 and such rejection should be withdrawn.

THE REJECTION OF CLAIMS 6, 11 AND 12 AS BEING UNPATENTABLE OVER ARMSTRONG IN VIEW OF HAWKINS OR BOTTIGLIERI PURSUANT TO 35 U.S.C. 103(a) SHOULD BE REVERSED BECAUSE THESE CLAIMS DEPEND FROM CLAIM 1.

As stated above, Claims 6, 11 and 12 depend from Claim 1 and Claims 6, 11 and 12 stand or fall together with claim 1.

Therefore, Claims 6, 11 and 12 are patentable for the same reasons as stated above that Claim 1 is patentable, and the rejection should be reversed.

### **IX. Conclusion**

Therefore, for all of the aforementioned reasons, it is respectfully submitted that the final rejections should be reversed and that the pending claims be found allowable. Enclosed herewith is the fee of \$160.00 due for the filing of this Appeal Brief. The Commissioner is also

authorized to charge any other fee which is due or to credit any fee overpayment which has been made to Deposit Account No. 18-1215.

Respectfully submitted,



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**APPENDIX A**

1. (Amended) A golf practice and exercise system, comprising a flexible, hollow uninflated practice ball of at least the approximate size of a non-inflated soccer ball and generally spherical and made of pliable material having a low coefficient of elastic restitution such when struck the practice ball travels a short distance relative to the striking force applied to it, and a target assembly against which the practice ball is propelled after being struck from a striking position a sufficient distance from the target assembly that when the practice ball is struck by a golf club swung by a golfer it travels in a direction imposed by the golfer's swing, whereby the golfer can practice to control the travel of the practice ball and to develop golf swing strength.

5. A golf practice and exercise system according to claim 1 wherein the target assembly includes an energy absorbing surface surrounded by and attached to a rigid frame, the rigid frame being maintained in proper spatial orientation by a frame support structure.

6. A golf practice and exercise system according to claim 5 wherein the energy absorbing surface is a mesh netting having a front surface and a back surface.

11. A golf practice and exercise system according to claim 6 wherein the frame support structure includes a base on which is supported the rigid frame, the base being of sufficient extent to maintain the rigid frame in the proper spatial orientation.

12. A golf practice and exercise system according to claim 6 wherein the frame support structure includes at least two triangular support structures, the triangular support structure being integral to vertical sides of the rigid frame, each triangular support structure having two angle members and a horizontal member, each member connected to the other two members at apexes.

18. A golf practice and exercise system according to claim 1 characterized further by a golf club.
19. A golf practice and exercise system according to claim 18 wherein the golf club is a conventional golf club.



## APPENDIX B



### Laws of the Game

July 2002

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Published by  
Fédération Internationale de Football Association  
11 Hitzigweg, 8030 Zurich, Switzerland

## Decisions of the International F.A. Board

- **Decision 1**  
If the crossbar becomes displaced or broken, play is stopped until it has been repaired or replaced in position. If a repair is not possible, the match is abandoned. The use of a rope to replace the crossbar is not permitted. If the crossbar can be repaired, the match is restarted with a dropped ball at the place where the ball was located when play was stopped. \* (see page 3)
- **Decision 2**  
Goalposts and crossbars must be made of wood, metal or other approved material. Their shape may be square, rectangular, round or elliptical and they must not be dangerous to players.
- **Decision 3**  
No kind of commercial advertising, whether real or virtual, is permitted on the field of play and field equipment (including the goal nets and the areas they enclose) from the time the teams enter the field of play until they have left it at half-time and from the time the teams re-enter the field of play until the end of the match. In particular, no advertising material of any kind may be displayed on goals, nets, flagposts or their flags. No extraneous equipment (cameras, microphones, etc.) may be attached to these items.
- **Decision 4**  
There shall be no advertising of any kind within the technical area or within one metre from the touch line and outside the field of play on the ground. Further, no advertising shall be allowed in the area between the goal line and the goal nets.
- **Decision 5**  
The reproduction, whether real or virtual, of representative logos or emblems of FIFA, confederations, national associations, leagues, clubs or other bodies is forbidden on the field of play and field equipment (including the goal nets and the areas they enclose) during playing time, as described in Decision 3.
- **Decision 6**  
A mark may be made off the field of play, 9.15 metres (10 yds) from the corner arc and at right angles to the goal lines to ensure that this distance is observed when a corner kick is being taken.

## Qualities and Measurements

The ball is:

- spherical
- made of leather or other suitable material
- of a circumference of not more than 70 cm (28 ins) and not less than 68 cm (27 ins)
- not more than 450 g (16 oz) in weight and not less than 410 g (14 oz) at the start of the match
- of a pressure equal to 0.6 – 1.1 atmosphere (600 – 1100 g/cm<sup>2</sup>) at sea level (8.5 lbs/sq in 15.6 lbs/sq in)

## LAW 2 – The Ball

### Replacement of a Defective Ball

If the ball bursts or becomes defective during the course of a match:

- the match is stopped
- the match is restarted by dropping the replacement ball at the place where the first ball became defective \* (see page 3)

If the ball bursts or becomes defective whilst not in play at a kick-off, goal kick, corner kick, free kick, penalty kick or throw-in:

- the match is restarted accordingly

The ball may not be changed during the match without the authority of the referee.

